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EXAMINER
VIG, NARESH

ART UNIT	PAPER NUMBER
3629	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on _04 May 2006_.

2a) ☐ This action is **FINAL**.   2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) _6-10_ is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) _6-10_ is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a) ☐ All b) ☐ Some * c) ☐ None of:

      1. ☐ Certified copies of the priority documents have been received.

      2. ☐ Certified copies of the priority documents have been received in Application No. _____.

      3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date _____.

5) ☐ Notice of Informal Patent Application

6) ☐ Other: _____.

DETAILED ACTION

Claim Objections

Claims 7 – 10 are objected to under 37 CFR 1.75(c), as being of improper

dependent form for failing to further limit the subject matter of a previous claim.

Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s)

in proper dependent form, or rewrite the claim(s) in independent form. As currently

claimed, it is deemed that the limitations in the dependent claims 7 - 10 replaces

claimed limitations of the independent claim 6.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly
claiming the subject matter which the applicant regards as his invention.

Claims 6 – 10 are rejected under 35 U.S.C. 112, second paragraph, as being

indefinite for failing to particularly point out and distinctly claim the subject matter which

applicant regards as the invention. As currently claimed, it is not clear whether the

claimed invention is directed to configuring an automation installation, or, providing of

configuring data to a buyer, or something else because there is no configuration

performed by the claimed invention as recited in the preamble.

As for claims 7 – 10, it is not clear whether the limitations in the claims are

inclusive of the limitations of Claim 1 upon which they claim dependency, or, they are

exclusive the of limitations as claimed in claim 6.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of
matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the
conditions and requirements of this title.

Claims 6 – 10 are not patentable because the claimed invention is directed to

non-statutory subject matter.

Applicant's claimed invention is directed to storing configuration data (which can

be a text document) in a database by a provider; and rendering the configuration data

available from the database in form of a copy for acquisition by a buyer (an operator

making a copy of the text document and providing if to the buyer).

Based on Supreme Court precedent[1] and recent Federal Circuit decisions, A

"process" under § 101 must (1) be tied to another statutory class (such as a particular

apparatus) or (2) transform underlying subject matter (such as an article or materials) to

a different state or thing or (3) the use of a specific machine or transformation of an

article must impose meaningful limits on the claim's scope to impart patent-eligibility,

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[1] *Diamond v. Diehr, 450 U.S. 175, 184 (1981); Parker v. Flook, 437 U.S. 584, 588 n.9 (1978); Gottschalk v. Benson, 409 U.S.
63, 70 (1972); Cochrane v. Deener, 94 U.S. 780,787-88 (1876)*

furthermore, the involvement of the machine or transformation in the claimed process

must not merely be insignificant extra-solution activity[2]. If neither of these requirements

is met by the claim, the method is not a patent eligible process under § 101 and should

be rejected as being directed to nonstatutory subject matter. Moreover, the recitation of

"computer implemented" in the preamble with the absence of a computer in the body of

the claim or a lack of "another statutory class" in the body of the claim does not make

the claim statutory.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

Claims 6 – 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Morrison US Patent 7,085,744 in view of archived web pages of www.downlad.com.

Regarding claim 6, Morrison teaches concept of system and method for providing

digital content from a server upon request from a purchaser. Morrison does not explicitly

recite said digital content to be configuration data. However, Download.com teaches

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[2] *The Supreme Court recognized that this test is not necessarily fixed or permanent and may evolve with technological advances.*

system and method for providing configuration data as digital content from a server to a purchaser upon the acquisition request from the purchaser.

Therefore, at the time of invention, it would have been obvious to one of ordinary skill in the art to modify one of ordinary skill in the art to modify Morrison by adopting teachings of Download.com to expand the business model to sell software online, apply a known technique to a known device (method, or product) ready for improvement to yield predictable results, known work in one field of endeavor may prompt variations of it for use in either the same field or a different one based on design incentives or other market forces if the variations would have been predictable to one of ordinary skill in the art.

Morrisson in view of Download.com teaches concept and capability configuring an automation installation by:

storing configuration data in a database by a provider [Morrison, Fig. 2 and disclosure associated with the Figure; Download.com, page 5]; and

rendering the configuration data available from the database in form of a copy for acquisition by a buyer [Morrison, Fig. 2 and disclosure associated with the Figure; Download.com, page 5].

Regarding claim 7, Morrisson in view of Download.com teaches concept and capability for storing in the database a description associated with the configuration data

and rendering the description available for acquisition by the buyer [Morrison, Fig. 2 and disclosure associated with the Figure; Download.com, page 5].

Regarding claim 8, Morrisson in view of Download.com teaches concept and capability for transferring a given value to the database by the buyer prior to acquiring a copy of the configuration data from the database [Morrison, Fig. 2 and disclosure associated with the Figure; Download.com, page 5].

Regarding claim 9, Morrisson in view of Download.com teaches concept and capability for transferring a given value to the provider for each copy of the configuration data acquired from the database [Morrison, Fig. 2 and disclosure associated with the Figure].

Regarding claim 10, Morrisson in view of Download.com teaches concept and capability wherein the database can be connected to the Internet [Morrison, Fig. 2 and disclosure associated with the Figure; Download.com, page 5].

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Applicant is required under 37 CFR '1.111 (c) to consider the references fully when responding to this office action.

1. Galensky et al. US Patent 6,845,398

2. Krantz et al. US Patent 7,284,962

3. Wiser et al. US Patent 6,385,596

Any inquiry concerning this communication or earlier communications from the examiner should be directed to NARESH VIG whose telephone number is (571)272-6810. The examiner can normally be reached on Mon-Thu 7:00 - 5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (571) 272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Naresh Vig/
February 26, 2010 Primary Examiner, Art Unit 3629